

### **REMARKS**

This paper responds to the Final Office Action dated March 17, 2010. No claims are presently amended. Claims 1-16 and 26 were previously canceled, and claims 37-41 were previously withdrawn. No claims are presently added. As a result, claims 17-25 and 27-36 remain pending further prosecution in this application.

#### **The Rejection of Claims Under § 103**

Claims 17-25 and 27-36 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over McBrayer et al. (U.S. Patent 7,499,871, “McBrayer”) in view of Official Notice. A determination of obviousness requires a factual showing that “the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”<sup>1</sup> “The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, . . . secondary considerations.”<sup>2</sup> Applicants respectfully submit that a determination of obviousness is not established for the reason that the scope and content of the cited references, even if combined, do not teach or suggest all claimed elements or support rational inferences that one skilled in the art reasonably would be expected to draw to reach all claimed elements.

Each of independent claims 17, 28, and 35-36 recites, in part, “the providing of the answer . . . including **publishing the answer on the listing for the item.**”<sup>3</sup> The Final Office Action cited column 10, lines 37-50 of McBrayer as allegedly teaching this claim element.<sup>4</sup> The cited passage of McBrayer refers to FIG. 19 of McBrayer,<sup>5</sup> which illustrates a question box, an

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<sup>1</sup> *Graham v. John Deere*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966).

<sup>2</sup> *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. at 467, *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 406-7, 82 U.S.P.Q.2d 1385, 1390 (2007), cited in *Ex parte Frye*, Appeal No. 2009-006013 (BPAI 2010) (precedential).

<sup>3</sup> Emphasis added.

<sup>4</sup> Final Office Action at 4.

<sup>5</sup> McBrayer at column 10, line 37.

answer box, a checkbox labeled “Make Public,” and a button labeled “Submit Answer.”<sup>6</sup> The cited passage of McBrayer simply states that:

The buyer may . . . post answers to requests for information . . . . When answering a question, the buyer has several options for distributing the answer 440. The buyer may choose to make the answer public so that all bidding suppliers may view the information.<sup>7</sup>

Mere discussion of posting or distributing answers makes no mention whatsoever of publishing the answer **on the listing for the item**. FIG. 19 of McBrayer is silent with respect to a listing for an item. Nothing in the cited passage of McBrayer or in the remainder of McBrayer discusses publishing an answer on a listing for an item. As a result, McBrayer fails to disclose this claim element.

With respect to Official Notice, “an examiner may take official notice of **facts** not in the record or rely on ‘**common knowledge**’ in making a rejection.”<sup>8</sup> “[T]he notice of facts beyond the record which may be taken by the examiner must be ‘capable of such instant and unquestionable demonstration as to defy dispute.’”<sup>9</sup> “If such notice is taken, the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.”<sup>10</sup>

The Final Office Action stated that “it is **noted that** McBrayer discloses the claimed invention except it is the buyer posting the answer rather than the seller.”<sup>11</sup> The Final Office Action does not set forth any basis for such reasoning. Nothing in the Final Office Action provides specific factual findings predicated on sound technical and scientific reasoning to support a conclusion of common knowledge. Applicants respectfully assert that the officially noted proposition that “**McBrayer discloses the claimed invention** except it is the buyer posting the answer rather than the seller” is not a fact and not common knowledge. Rather, the officially

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<sup>6</sup> *Id.* at FIG. 19.

<sup>7</sup> *Id.* at column 10, lines 39–44.

<sup>8</sup> MPEP § 2144.03.

<sup>9</sup> *In re Ahlert*, 424 F.2d 1088, 1091, 165 U.S.P.Q 418, 420 (CCPA 1970); *see* MPEP § 2144.03(A).

<sup>10</sup> MPEP § 2144.03(B).

<sup>11</sup> Final Office Action at 3, emphasis added.

noted proposition is merely a conclusory statement comparing McBrayer to the claims of the instant application, which are not in common knowledge. Hence, Applicants respectfully assert that the officially noted proposition does not constitute common knowledge and respectfully demand that the Examiner provide specific factual findings predicated on sound technical and scientific reasoning to support a conclusion of common knowledge, as required by the MPEP.

Moreover, the officially noted proposition is not a fact and not common knowledge, at least because the proposition is false. As noted above, McBrayer fails to disclose at least the claim element of publishing the answer **on the listing for the item**. Accordingly, Applicants respectfully assert that the officially noted proposition is not “capable of such instant and unquestionable demonstration as to defy dispute,”<sup>12</sup> as required by law and the MPEP. Accordingly, Applicants respectfully demand that the Examiner produce authority for the officially noted proposition.

The Final Office Action stated that “[i]t would have been obvious . . . to provide the **seller** the functionality to correspond with the **buyer** as is defined by McBrayer, since it has been held that a mere **reversal of parts** involves only routine skill in the art.”<sup>13</sup> In support of this statement, the Final Office Action cited to *In re Einstein*,<sup>14</sup> which indeed noted that “a mere reversal of the essential **working parts of a** previously patented **device** did not constitute invention.”<sup>15</sup> Applicants respectfully assert that nowhere in McBrayer is a seller or a buyer described as a “working part” of any “device.” Within any device disclosed in McBrayer, reversal of two “essential working parts” of that device would not, and cannot, result in the subject matter of the instant claims. Thus, the citation to *In re Einstein* lends no support to the rejections of the instant claims.

For at least these reasons, the scope and content of McBrayer, considered singly or in conjunction with Official Notice, do not teach or suggest all claimed elements or support rational

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<sup>12</sup> *In re Ahlert*, 424 F.2d at 1091, 165 U.S.P.Q. at 420; see MPEP § 2144.03(A).

<sup>13</sup> Final Office Action at 3, emphasis added.

<sup>14</sup> *Id.* at 3.

<sup>15</sup> *In re Einstein*, 46 F.2d 373, 374, 18 C.C.P.A. 885, 887 (CCPA 1931), punctuation omitted, emphasis added.

inferences that one skilled in the art reasonably would be expected to draw to reach all claimed elements. As a result, a determination of obviousness is not established with respect to any of independent claims 17, 28, and 35-36, and their respective dependent claims, including claims 18-25, 27, and 29-34. Moreover, the dependent claims may each be patentable based on limitations recited therein. Thus, Applicants respectfully request that these rejections be reconsidered and withdrawn and that the claims be allowed.

In “Response to Arguments,” the Final Office Action stated that “Applicant further argues that the limitations in the **independent** claims were not addressed.”<sup>16</sup> In the interest of clarity, Applicants respectfully point out that Applicants’ previous Response, filed September 2, 2009, contained no statement alleging that independent claims were not addressed. Applicants’ previous Response actually stated that the rejections of “**dependent** claims 18-27 and 29-34” were not supported.<sup>17</sup>

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<sup>16</sup> Final Office Action at 8, emphasis added.

<sup>17</sup> Response at 11, “Although **dependent claims** 18-27 and 29-34 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over McBrayer in view of Official Notice, nothing in the Office Action articulates any specific reasoning to support these rejections,” footnote omitted, emphasis added.

**CONCLUSION**

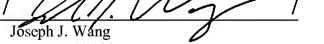
Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (408) 278-4048 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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Date 17 May 2010

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 17th day of May, 2010.

Chris Bartl  
Name

  
Signature